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Mailed: 3/8/06
In re application of :
Mikumo et al. :
Serial No. 10/069,848 :
Filed: February 28, 2002 :
For: INDICATOR FOR PLASMA STERILIZATION :
td
DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed November 3, 2005.

A Request for Continued Examination was filed in the instant application on May 11, 2005. An amendment to the claims was also filed at the same time. Specifically, an amendment was made to independent claim 17 and newly presented claim 40 was added. The examiner prepared a first action final which was mailed on July 19, 2005. Applicants requested withdrawal of the finality of the office action and further requested that a new office action be prepared because the examiner did not address newly added claim 40. The examiner prepared a new office action addressing newly added claim 40, which was mailed on November 3, 2005. The examiner also made this office action final. Applicants requested that the finality be withdrawn in a telephone conference with the examiner, however agreement was not reached.

On December 7, 2005, the instant petition was timely filed to formally request the withdrawal of the finality of the November 3, 2005 office action

DECISION

As set forth in the petition, the standard for making an Office action final is set forth in section 706.07(b) of the MPEP which states:

706.07(b) Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

In the instant application, the examiner stated in the final office action that all of the claims are drawn to the same invention claimed in the earlier application. This is clearly in error. The amendment to independent claim 17 and newly presented claim 40 are directed to subject matter which was not previously claimed. Therefore, the claims are not drawn to the same invention

that was previously claimed. Accordingly, the finality of the office action was improper and the petition is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response to the November 3, 2005 office action continues to run. Extensions of time may be obtained to file any amendments. Such amendments will be treated as an amendment under 37 CFR 1.111 or 1.112 and will be entered.



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